

claim amendments suggested by the Examiner and agreed upon during the Examiner Interview, and the parent application was allowed.

By this Preliminary Amendment, the present continuation application includes claims 64-73. The correspondence between claims 64-72 and those of the parent application at the time the Request was filed is provided below:

<u>Current Claim No.</u>	<u>Claim No. in Parent Application</u>
64	64
65	94
66	125
67	137
68	149
69	158
70	159
71	160
72	161

In view of the following remarks, applicants respectfully submit that the claims should be allowable over the cited references relied upon in the Final Action for the parent application.

Turning to the rejections in the Final Action for the parent application, claims 64-66, 69, 71-79, 92-96, 98, 100, 101, 103-111, 123-127, 131, 132, 134, 137-140, 144, 145, 149-151, 153, 154, and 160 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bouricius et al. (U.S. Patent 4,326,098) and an Official Notice that will be discussed in detail below. Claims 68, 80, 97, 111, 133, 147, 155, 158 and 161 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Bouricius et al. reference and various Official Notices. Claim 159 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Schneier in view of further Official Notices.

To put the discussion in perspective, a brief recount of the prosecution of the parent application up to the Final Action is believed to be useful. In the first Office Action for the

parent application, independent claims 64, 94, 125, 137, 149, and 160 as well as selected dependent claims were rejected under 102(b,e) as being anticipated by Bouricius et al. Claim 159 was rejected under 35 U.S.C. § 102(b) as being anticipated by Schneier. Independent claims 158 and selected dependent claims were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bouricius et al. in combination with Official Notices. With respect to claim 137 that was directed to an "authenticator", the first Office Action rejected the claim by asserting: "The applicants' claimed authenticator performs the Applicant's claimed method for authenticating." In the responsive Amendment, claim amendments were made such that all the independent claims require an authenticator that functions as a non-interested third party with respect to the sender and the recipient and generates and secures the dispatch authentication information. The second Office Action for the parent application, which was made final, repeated the same grounds of rejection given in the first Office Action, but added an Official Notice regarding the authenticator, and converted the original Section 102 rejections into Section 103 rejections.

Applicants submit that the Final Action for the parent application did not fully develop the grounds of the rejections. As described above, the first Office Action did not give due weight to the "authenticator," and applicants responded by adding this limitation to each of the independent claims to emphasize its importance. The Final Action, however, relied on an Official Notice to find the authenticator. Specifically, the Office Action asserted:

Although Bouricius does not specifically teach an authenticator functioning as a non-interested third party with respect to the sender and the recipient, such an authenticator acting in such a manner is a feature that is old and well known in the art. Therefore it would have been obvious to one of ordinary in the art at the time the invention was made to have incorporated this feature into the method of Bouricius et al.

It is applicants' position that it would not have been obvious to combine any "such an authenticator" with the system of Bouricius et al. to reach the claimed invention. First of all, applicants respectfully traverse the assertion in the Final Action that "such an authenticator acting in such a manner is a feature that is old and well known in the art." Second, applicants

submit that it would not have been obvious to combine "such an authenticator" with the system of Bouricius et al. to somehow reach the claimed invention. This is because the system of Bouricius et al. and the present invention are based on two entirely different conceptual models. The system of Bouricius et al. is based on a model in which the sender and recipient of a dispatched document exchange signed copies of the document as proof of the dispatch. Thus, both the sender and recipient in the system of Bouricius et al. are responsible for generating, exchanging, and storing the proof of a dispatched document. The system of Bouricius et al. has a vault for assisting the sender and recipient of the dispatch to accomplish authenticated correspondence with each other. Although the vault is a non-interested third party in that process, it does not generate or secure any dispatch evidence. Rather, it serves merely as a secure and reliable communication channel between the correspondents. In this regard, by relying on the Official Notice regarding the "authenticator" limitations, the Office Action clearly recognized that the vault of Bouricius et al. is not the authenticator of the claimed invention.

In sharp contrast to the Bouricius et al. approach, in the claimed invention, neither the sender nor the recipient is concerned with generating or storing authentication information for the dispatch. Rather, it is the authenticator operating as a non-interested third party that generates the authentication information and secures it from tampering by the sender and/or the recipient. It is critical to note that since the sender and recipient in the system of Bouricius et al. are themselves responsible for generating and storing the proof of dispatch, that system does not have any need or any room for an authenticator of the claimed invention. This is because the signing of the dispatched document by the sender and recipient and exchanging the signed document is already sufficient for certifying the contents and dispatch of the document. Thus, it would not have been obvious to try to combine such an authenticator with the system of Bouricius et al. to somehow reach the claimed invention.

Accordingly, independent claims 64-69 and 71 (correspond to claims 64, 94, 125, 137, 149, 158, and 160 of the parent application, respectively), which all include the

"authenticator" limitation, should be allowable even if it is assumed that the Official Notice regarding the authenticator could be adequately supported. Claim 72 depends from claim 71 and should therefore also be allowable.

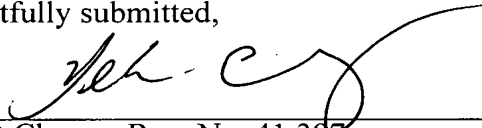
Independent claim 70 corresponds to claim 159 of the parent application, which was rejected in the Final Action for the parent application over Schneier in view of the Official Notice about the authenticator. According to the Final Action, Schneier explains a public certificate. As discussed above, the context and manner in which the authenticator operates is important to the consideration of patentability. The certificate issuing operation of Schneier is, however, not related to authenticating a dispatch and its contents from a sender to a recipient, and the certificate authority of Schneier is not the authenticator of the claimed invention. Thus, it would not have been obvious to combine the system of Schneier with authenticator to reach to claimed invention. Accordingly, claim 70 should be allowable. Claim 73 depends from claim 70 and thus should also be allowable.

Conclusion

In view of the foregoing, applicants respectfully submit that the present application is in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue.

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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